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Paper 108
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3
4 UNITED STATES PATENT AND TRADEMARK OFFICE
5 BOARD OF PATENT APPEALS AND INTERFERENCES
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8 Patent Interference 105,685 McK
9 Technology Center 1600

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12

WYETH

13 (Named inventors: Anthony F. Hadfield, Syed M. Shah,
14 James A. Provost, Aeri Park, Rex A. Shippelt,
15 Brenton W. Russell, and Beat T. Weber),
16 Patents 6,673,838 B2 and 7,291,347 B2,

17

18

Junior Party,

19

20

v.

21

22

SEPRACOR, INC.

23 (Named inventors: Thomas P. Jerussi, Chrisantha H. Senanayake,
24 and Nandkumar N. Bhongle)

25 Applications 10/720,134, 11/091,518 and 12/011,083,

26

27

Senior Party.

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30 Before: Fred E. McKelvey, *Senior Administrative Patent Judge*.

31

32 **SECOND REDECLARATION OF INTERFERENCE**

33 In order to conform the interference to the various decisions on
34 motions, the interference is redeclared as follows.

- 35 1. Sepracor is made senior party and Wyeth is made junior party.
36 2. In filing future papers, the parties should use the heading set out
37 above.

3. Count 5 remains as follows:

Count 5

The compound of claim 1 of Hadfield U.S. Patent 6,673,838 B2

or

the compound of claim 60 of Jerussi application 10/720,134.

Hadfield U.S. Patent 6,673,838 B2 claim 1 reads:

A compound which is O-desmethyl venlafaxine succinate.

Jerussi application 10/720,134 claim 60 reads:

A compound which is O-desmethylvenlafaxine succinate.

The claims of the parties are:

Hadfield '838: 1-46

Jerussi '134: 60-71

The claims that correspond to Count 5 are:

Hadfield '838: 1-3

Jerussi '134: 60-62

The claims that do not correspond to Count 5 are:

Hadfield '838: 4-46

Jerussi '134: 63-71

With respect to Count 5, the parties are accorded an earlier

21 constructive reduction to practice (*i.e.*, benefit for the purpose of priority) of
22 the following applications:

Hadfield: Provisional application 60/268,214
filed 12 February 2001

Provisional application 60/297,963
filed 13 June 2001

Jerussi: Application 09/527,442,
filed 17 March 2000

Application 10/720,134
filed 25 November 2003

Provisional application 60/127,938
filed 6 April 1999

Provisional application 60/167,906
filed 30 November 1999

4. Count 6 remains as follows:

Count 6

An oral dosage form comprising O-desmethyl venlafaxine succinate, wherein the oral dosage form is a tablet or capsule.

The claims of the parties are:

Jerussi '083: 60-63

Hadfield '347: 1-9

The claims that correspond to Count 6 are:

Jerussi '083: 60-63

Hadfield '347: 1-9

The claims that do not correspond to Count 6 are:

Jerussi '083: None

Hadfield '347: None

With respect to Count 6, the parties are accorded an earlier

reduction to practice (*i.e.*, benefit for the purpose of priority) of
g applications:

1 Hadfield: Provisional application 60/268,214
2 filed 12 February 2001

3
4 Provisional application 60/297,963
5 filed 13 June 2001

6
7 Jerussi: Application 09/527,442,
8 filed 17 March 2000

9
10 Application 10/720,134
11 filed 25 November 2003

12
13 Provisional application 60/127,938,
14 filed 6 April 1999

15
16 Provisional application 60/167,906
17 filed 30 November 1999

18 5. Count 7 remains as follows:

19 Count 7

20 The composition of claims 23, 25 or 26 of

21 Hadfield U.S. Patent **6,673,838 B2**

22 or

23 the composition of claims 1 or 64 of Jerussi application **11/091,518**

24 or

25 the composition and dosage form claims 63-65 of

26 Jerussi application **10/720,134.**

27
28 Hadfield claim 23 reads:

29 A pharmaceutical composition comprising O-desmethyl
30 venlafaxine succinate and a pharmaceutically acceptable carrier
31 or excipient.

1 Hadfield claim 25 reads:

2 A pharmaceutical dosage form comprising a therapeutically
3 effective amount of O-desmethyl venlafaxine succinate and a
4 pharmaceutically acceptable carrier or excipient.

5 Hadfield claim 26 reads:

6 An oral dosage form comprising a therapeutically effective
7 amount of O-desmethyl venlafaxine succinate and a
8 pharmaceutically acceptable carrier or excipient.

9 Jerussi claim 1 of application 11/091,518 reads:

10 A pharmaceutical composition which comprises
11 (\pm)-O-desmethylvenlafaxine succinate and a pharmaceutically
12 acceptable carrier or excipient, wherein (\pm)-O-
13 desmethylvenlafaxine is present at an amount of about 50 mg.

14 Jerussi claim 64 of application 11/091,518 reads:

15
16 A pharmaceutical composition which comprises
17 (\pm)-O-desmethylvenlafaxine succinate and a pharmaceutically
18 acceptable carrier or excipient, wherein (\pm)-O-
19 desmethylvenlafaxine is present at an amount of about 100 mg.

20 Jerussi claim 63 of application 10/720,134 reads:

21
22 A pharmaceutical composition comprising a therapeutically
23 effective amount of O-desmethylvenlafaxine succinate and a
24 pharmaceutically acceptable carrier or excipient.

1 Jerussi claim 64 of application 10/720,134 reads:

2
3 A pharmaceutical dosage form comprising a therapeutically
4 effective amount of O-desmethylvenlafaxine succinate and a
5 pharmaceutically acceptable carrier or excipient.

6 Jerussi claim 65 of application 10/720,134 reads:

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8 An oral dosage form comprising a therapeutically effective
9 amount of O-desmethylvenlafaxine succinate and a
10 pharmaceutically acceptable carrier or excipient.

11
12 The claims of the parties are:

13 Hadfield '838: 1-46

14 Jerussi '518: 1, 12 and 60-69

15 Jerussi '134: 60-71

16 The claims that correspond to Count 7 are:

17 Hadfield '838: 23-34 and 46

18 Jerussi '518: 1, 12 and 60-69

19 Jerussi '134: 63-71

20 The claims that do not correspond to Count 7 are:

21 Hadfield '838: 1-22 and 35-45

22 Jerussi '518: None

23 Jerussi '134: 60-62

24 With respect to Count 7, the parties are accorded an earlier
25 constructive reduction to practice (*i.e.*, benefit for the purpose of priority) of
26 the following applications:

27 Hadfield: Provisional application 60/268,214
28 filed 12 February 2001

Provisional application 60/297,963
filed 13 June 2001

Jerussi: Application 09/527,442,
filed 17 March 2000

Application 10/720,134
filed 25 November 2003

Provisional application 60/127,938,
filed 6 April 1999

Provisional application 60/167,906
filed 30 November 1999

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